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EXAMINER

WOODALL, NICHOLAS W

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,629

Applicant(s)

ERRICO ET AL.

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5,9 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 6-8 and 10-14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/23/2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities: claim 7 states, "is effected by at least one of a dimension of at least one of the prongs and a material strength of at least one of the prongs". The examiner believes the claim should read, "is effected by at least one of a dimension of at least one of the prongs or a material strength of at least one of the prongs". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 12 recites the limitation "the plunger" in line 1. There is insufficient antecedent basis for this limitation in the claim. The examiner recommends making claim 12 dependent from claim 11 to correct the lack of antecedent basis.
5. Claim 15 states, "wherein at least one of the prongs terminates in at least one extent". The examiner is unclear on the limitation set forth by this claim and interprets the claim to mean the prong terminates into an extension and will be understood as such for examination purposes. Claims 16-18 are also unclear because of the dependency to claim 15.

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6. Claim 17 states, "wherein at least one of the extents has a thickness less than a width of an annular groove of the distraction device". The examiner is unclear on the limitation set forth by this claim because there is no prior reference to an annular groove in the claims or dimension given for the groove.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-5, 15, and 18-20 are rejected as understood under 35 U.S.C. 102(b) as being anticipated by Farris (U.S. Patent 5,782,830).

Regarding claim 1, Farris discloses a device comprising an extension having a longitudinal axis, at least two prongs, and a sleeve (see Figure 1 below). The prongs are coupled to a fulcrum located at the distal end of the extension. Each prong further includes an extension that together defines a contractible and expandable holding enclosure. The sleeve surrounds at least a portion of the distal end of the extension, is collinear with the longitudinal axis of the extension, and is rotatable about the extension. Regarding claim 3, Farris discloses a device further comprising a handle, which has a distal end connected to the proximal end of the extension. Regarding claim 4, Farris

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discloses a device further comprising a flange. Regarding claim 5, Farris discloses a device wherein the holding enclosure is cylindrical. Regarding claim 15, Farris discloses a device wherein at least one prong terminates into at least one extension. Regarding claim 18, Farris discloses a device wherein at least one of the extensions is rigid (see Figure 2 below). Regarding claim 19, Farris discloses a device wherein the extensions are semicircular with inner surfaces facing each that define the holding enclosure. With regards to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Farris, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Figure 1

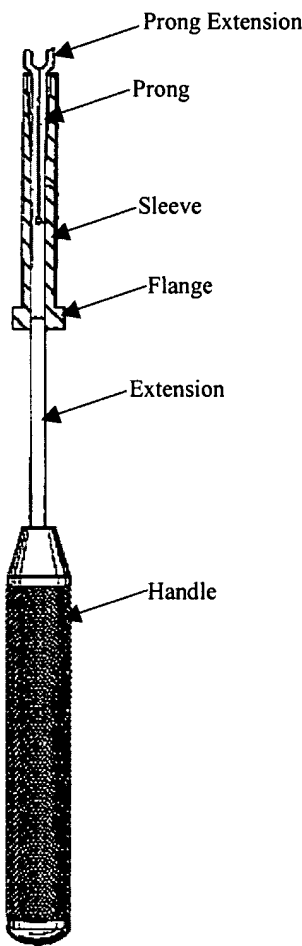
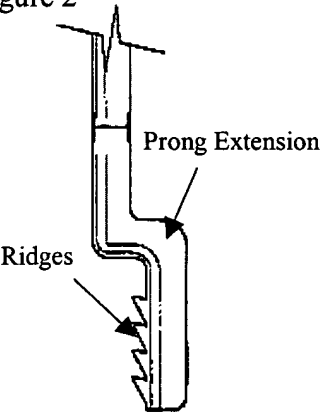


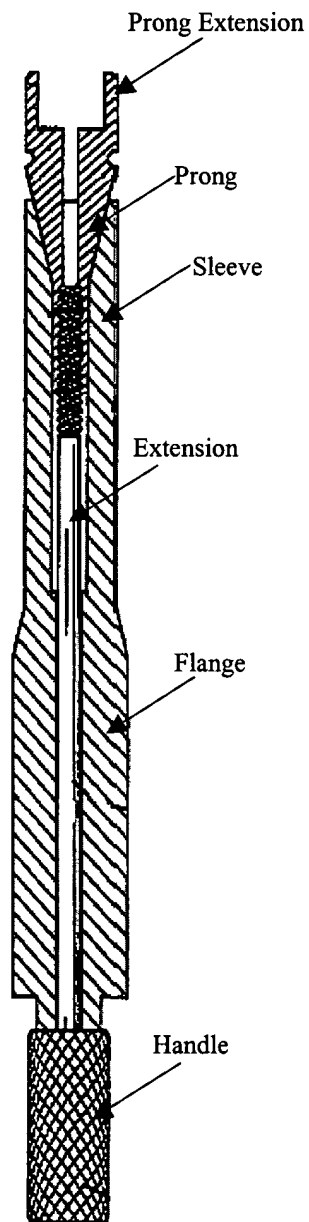
Figure 2



9. Claims 1-4, 9, and 15-16 are rejected as understood under 35 U.S.C. 102(b) as being anticipated by Steffe (U.S. Patent 5,443,514).

Regarding claim 1, Steffe discloses a device comprising an extension having a longitudinal axis, at least two prongs coupled to a fulcrum located at the distal end of the extension, and a sleeve (see Figure 3 below). Each prong further comprises an extension that together defines a contractible and expandable holding enclosure. The sleeve surrounds at least a portion of the distal end of the extension, is collinear with the longitudinal axis of the extension, and is rotatable about the extension. Regarding claim 3, Steffe discloses a device further comprising a handle, which has a distal end connected to the proximal end of the extension. Regarding claim 4, Steffe discloses a device further comprising a flange. Regarding claim 16, Steffe discloses a device wherein at least one of the extensions has a thickness less than the width of an annular groove on the device. With regards to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Steffe, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Figure 3



10. Claims 1-3, 9, and 15 are rejected as understood under 35 U.S.C. 102(e) as being anticipated by Hildebrand (U.S. Patent 6,923,814).

Regarding claim 1, Hildebrand discloses a device comprising an extension having a longitudinal axis, at least two prongs coupled to a fulcrum located at the distal

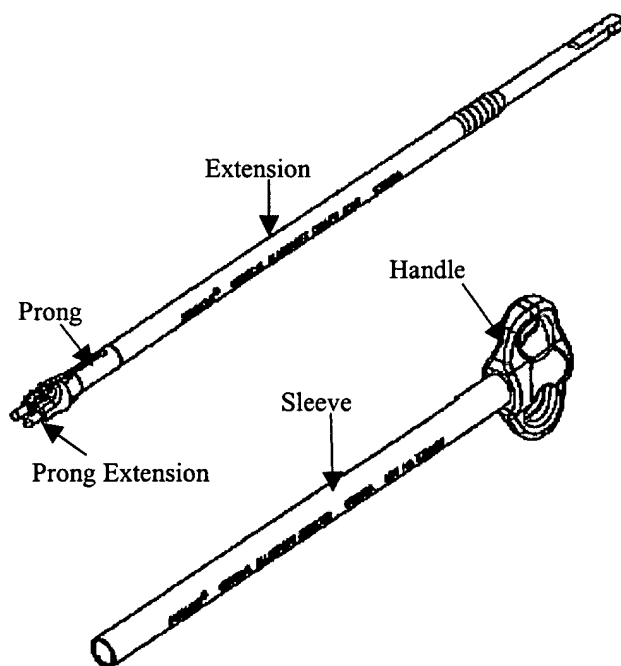
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end of the extension, and a sleeve (see Figure 4 below). Each prong further comprises an extension that together defines a contractible and expandable holding enclosure.

The sleeve surrounds at least a portion of the distal end of the extension, is collinear with the longitudinal axis of the extension, and is rotatable about the extension.

Regarding claim 3, Hildebrand discloses a device further comprising a handle, which has a distal end connected to the proximal end of the extension. Regarding claim 9, Hildebrand discloses a device wherein a thread is used to limit the amount of rotation of the sleeve. Regarding claim 15, Hildebrand discloses a device wherein at least one prong terminates into at least one extension.

Figure 4



Allowable Subject Matter

11. Claims 6-8 and 10-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claim 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

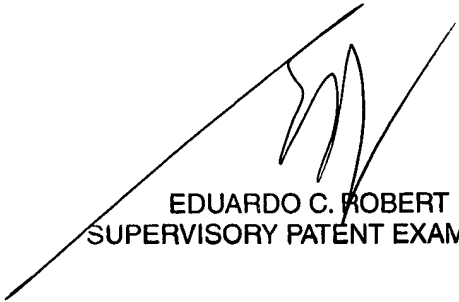
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER